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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/870,199

Filing Date: June 05, 1997

Appellant(s): WEBB, BRANFORD C.

Mark Flanigan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 23, 2007 appealing from the

Office action mailed April 19, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

Claim 13 is rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Claim 13 is improperly broadened. Such claim removes the limitation “, the series including a final filter having 0.5 UM opening”. Such claims remove the limitation that was relied on for the allowance of the parent application, and thus, cannot be removed. (See MPEP 1412.02). A claim is broader in scope than the original claims if it contains within its scope any conceived product or process, which would have infringed the original patent. A claim is broaden if it is broader in any one respect even though it might be narrower in other respects.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 13-23 are directed to the phrase filtering the gel through a series of filter to form a clear solution”. The specification has support for certain filters with specific um opening. However, the specification fails to provide support for the broad phrase of “a series of filters” in general with many possible openings.

Claims 1-56 are rejected as being based on a defective reissue declaration. The original declaration does not indicate certain limitations that were added to the claims.

Applicant is requested to submit a supplemental declaration for any amendments made during the prosecution. See MPEP 1414.01.

(10) Response to Argument

Appellant's arguments and remarks regarding the broadening of claim 13 have been carefully considered, but are not deemed to be persuasive. Appellant in his remarks argues that the examiner is rejecting claim 13 based on the recapture rule. Appellant goes on by saying that there is no evidence of record that the limitation of "the series including a final filter having 0.5 um opening" was relied upon for the allowance of the parent application. The arguments are not well taken. Appellant in the 132 declarations submitted on September 19, 2000 indicates the importance of the filtering process. Such declarations indicate that the unexpected properties of Cellugel material are due to the inventive filtering process, which removes the particulates and undesirable molecular weight components. It is also indicated that the removal of the particulate materials greater than 0.5 um prevents the cloudiness, which makes it difficult to see clearly during surgery. Therefore, the removal of the phrase "the series including a final filter having 0.5 um openings" shows the existence of the particulates greater than 0.5 um, the factor that was considered in the patentability of the parent application. Appellant's arguments regarding the 112 first paragraph have also been carefully considered, but are not deemed to be persuasive. Applicant refers to column 6, lines 3-12 of the specification for support for the phrase "filtering gel through a series

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of filters". However, column 6, lines 3-12 are drawn to a set of specific filters with the specific size and not a set of filters in general. Appellant's arguments regarding the submission of a supplemental declaration have been carefully considered. Appellant refers to the supplemental declaration submitted on April 4, 2004, indicating that such declaration refers to all the amendments made to the claimed invention. The arguments are not considered to be persuasive, since the declaration does not address the amendments made to claim 13.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Zohreh A Fay/

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